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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/594,070
Filing Date: June 14, 2000
Appellant(s): OEHRKE, TERRY L.

Mark C. Young
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/26/2008 appealing from the Office action mailed 12/31/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2007-1044

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,974,122	NELSON	10-1999
6,859,821	OZZIE	2-2005

2001/0036822

MEAD

11-2001

"DNS (domain name system)". Downloaded from

<http://web.archive.org/web/20000307002913/whatis.com/dns.htm> on 8/17/2007. Posted 2/29/2000.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson et al. in US Patent number 5,974,122, hereafter referred to as "Nelson."

With regard to claim 1, Nelson discloses a method for providing a messaging server on a computer network, the method comprising the steps of:

(a) routing a message to a messaging server (Nelson: Figure 2 (1)). The fax machines (122) and (124) are interpreted as being similar to messaging servers, as they both serve received messages to other entities on the network. It is noted that applicant lacks an explicit definition for the term "messaging server" that has a limiting

effect on the claim, so the broadest reasonable interpretation of a person of ordinary skill in the art of the term “messaging server” applies, which is a device or program which serves information to other devices or programs or provides some sort of other service to other devices or programs.);

(b) providing the message to a relay server when the messaging server is inoperable such that the message undeliverable to the messaging server (Nelson: Figure 2 (2) and Figure 1, steps (102) (104));

(c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational (Nelson: Figure 2 (3) and Figure 1, step (108)); and

(d) invoking another messaging server if the messaging server in step (c) does not become operational (Nelson: Figure 2 (134)). When the message is undeliverable, the message is forwarded to Fax Messaging Platform (134), which is interpreted as being another messaging server, as it provides the message to other devices or programs.).

With regard to claim 1, Nelson discloses

(e) routing the message to the other messaging server of step (d) (Nelson: Figure 2 (2)).

With regard to claim 4, Nelson discloses

(f) storing the message (Nelson: Figure 2 (134) and Abstract. The Fax messaging platform stores the message.); and

wherein step (e) comprises changing server information of the stored message (Figure 2. As the message is forwarded to the FAX messaging platform instead of to the destination, the server information of the stored message is different. It is noted that there is no requirement that server information stored in the message is changed, only that the server information is changed, which occurs when the message is on a different server.).

With regard to claim 5, Nelson discloses that step (c) comprises periodically attempting delivery of the message from the relay server to the messaging server (Nelson: Column 2, lines 50-63. The step of determining if the destination is available (to attempt to deliver the message) is performed a certain number of times over a period of time.).

With regard to claim 7, Nelson discloses

(d) sending the message to the messaging server in response to step (c) (Nelson: Column 4, lines 62-65).

With regard to claim 8, Nelson discloses

(f) sending the message to the other messaging server in response to step (e) (Nelson: Figure 2. When the system determines that the message is to be

forwarded to the FAX messaging platform, the server information reflect the new destination. As discussed in the rejection of claim 4, the server information does not need to be stored in the message or anywhere else.).

Claim Rejections - 35 USC § 102

Claims 1, 3-5, 7-9, 11-13, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozzie et al. in US Patent 6,859,821 B1, hereafter referred to as "Ozzie."

With regard to claim 1, Ozzie discloses a method for providing a messaging server on a computer network, the method comprising the steps of:

(a) routing a message to a messaging server (Ozzie: Figure 8 and Column 16, lines 35-54. The peer units are interpreted as being equivalent to messaging server, as the peer units serve messages to a destination.);

(b) providing the message to a relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server ((Ozzie: Figure 8 and Column 16, lines 35-54. If Peer Unit 802A attempts to send a message to Peer Unit 802C, and the presence server 812 detects that Peer 802C is off-line, the message is forwarded to relay 814 instead.);

(c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational (Ozzie: Figure 8 and Column 16, lines 35-

54. When peer unit 802C is back on-line, the message is forwarded to peer unit 802C.); and

(d) invoking another messaging server if the messaging server in step (c) does not become operational (Ozzie: Figure 8 and Column 16, lines 35-54).

With regard to claim 9, Ozzie discloses a computer network for providing a messaging service, the network comprising:

a messaging server (Ozzie: Figure 8 and Column 16, lines 35-54);

a DNS server operable to route a message to the messaging server (Ozzie: Column 7, lines 6-11 and lines 46-50. All components are identified by URL, which means that a DNS server must be present in order to translate the URL into a network address. Further, DNS servers are used on the Internet, which the system of Ozzie can be performed over.);

a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server (Ozzie: Figure 8 and Column 16, lines 35-54);

wherein the relay server is operable to re-route the message from the relay server to the messaging server if the messaging server becomes operational (Ozzie: Figure 8 and Column 16, lines 35-54); and

another messaging server, the other messaging server invoked by the relay server if the messaging server does not become operable such that the message is

undeliverable to the messaging server in response to the re-routing (Ozzie: Figure 8 and Column 16, lines 35-54).

With regard to claim 3, Ozzie discloses

(e) routing the message to the other messaging server of step (d) ((Ozzie: Figure 8 and Column 16, lines 35-54. The message is routed to relay 814 when the peer unit 802C is off-line.).

With regard to claim 4, Ozzie discloses

(f) storing the message (Ozzie: Figure 8 and Column 16, lines 35-54. The message is stored in the relay until peer unit 802C is on-line.); and

wherein step (e) comprises changing server information of the stored message (Ozzie: Figure 8 and Column 16, lines 35-54. The message is transmitted to the URL associated with relay 814, so the server information is changed. It is noted that there is no requirement that the server information is stored in the message or anywhere else.).

With regard to claim 5, Ozzie discloses that step (c) comprises periodically attempting delivery of the message from the relay server to the messaging server (Ozzie: Column 16, lines 62-67 and column 17, lines 10-23. The presence server can poll the peer unit periodically. Also, the peer unit can be notified that a peer wishes to send a message from time to time. These are interpreted as being similar to attempting

to deliver the message, as the presence server is used to determine if the message can be delivered.).

With regard to claim 6, Ozzie discloses

(d) invoking another messaging server when the message is undeliverable to the messaging server in step (c) (This limitation is substantially similar that presented in claim 2, and is rejected for substantially similar grounds under Ozzie.).

With regard to claim 7, Ozzie discloses

(d) sending the message to the messaging server in response to step (c) (Ozzie: Figure 8 and Column 16, lines 35-54).

With regard to claim 8, Ozzie discloses

(f) sending the message to the other messaging server in response to step (e) (Ozzie: Figure 8 and Column 16, lines 35-54. The message is sent to the relay server 814, which constitutes another messaging server.).

With regard to claims 11-13 and 15-16, the invention claimed is substantially similar to that claimed in claims 3-5 and 7-8, and are rejected for substantially similar reasons.

Claim Rejections - 35 USC § 102

Claims 1, 3-5, 7-9, 11-13, 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mead et al. in US Patent Application Publication US 2001/0036822, hereafter referred to as "Mead."

With regard to claim 1, Mead discloses a method for providing a messaging server on a computer network, the method comprising the steps of:

(a) routing a message to a messaging server (Mead: Figure 1. The message is routed from Home Mail Server 102 to Vehicle Server 110);

(b) providing the message to a relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server (Mead: This step only needs to be performed when the message is undeliverable. There is no requirement in the claim language that the message is undeliverable. Therefore, when the message is deliverable, the message only needs to be routed to the destination.);

(c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational (Mead: This limitation is interpreted as being only performed after step (b) if step (b) occurred, as the relay server only has the message if the message was undeliverable to the messaging server, so it cannot possibly be re-routed from the relay server if the relay server does not have the message.); and

(d) invoking another messaging server if the messaging server in step (c) does not become operational (Mead: Figure 1. First, it is noted that step (c) only needs

to occur when the messaging server was unavailable in step (b). Therefore, step (d) only needs to occur when the messaging server is unavailable in step (b), as step (d) only occurs after step (c). Therefore, when the servers of Mead are all available, so that the message is deliverable, the method as claimed is clearly performed.).

With regard to claim 9, Mead discloses a computer network for providing a messaging service, the network comprising:

- a messaging server (Mead: Figure 1, 110);

- a DNS server operable to route a message to the messaging server (Mead: Paragraph [0015] and Figure 1. Data network 104 can be the Internet, meaning that DNS servers must be present if the message is forwarded through the Internet.);

- a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server (Mead: Figure 1 and paragraphs [0015]-[0016]. The relay server is interpreted as being similar to the ground server 106 in figure 1. The message is delivered to the ground server whether it is deliverable to the vehicle server or not, so the DNS server is clearly operable to provide the message to the relay server whether or not the messaging server is inoperable...);

- wherein the relay server is operable to re-route the message from the relay server to the messaging server when if the messaging server becomes operational

(Mead: Figure 1. The relay server routes the message to the vehicle server, but can only do so when the vehicle server is able to receive messages.); and

another messaging server, the other messaging server invoked by the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server in response to the re-routing (Mead: Figure 1. The ground server (106) is always able (operable) to transmit the message to another messaging server (which is equivalent to invoking another messaging server, as a server is "invoked" when it has a communication transmitted to it.). The other messaging server never needs to be invoked as the claim is presented, rather, the messaging server only needs to be able to be invoked.).

With regard to claim 3, Mead discloses

(e) routing the message to the other messaging server of step (d) (Mead: It is noted that step (e) does not necessarily need to be performed if the message was deliverable in step (b) (see the rejection of claim 2 for further details). Therefore, when the message is deliverable in step (b), Mead clearly performs the method as claimed.).

With regard to claim 4, Mead discloses

(f) storing the message (Mead: Figure 1 and paragraph [0016]. Mead is dealing with e-mails, so the e-mails are clearly stored at multiple points throughout the system of Mead, including, at least, the destination server to await download by the user.); and

wherein step (e) comprises changing server information of the stored message (Mead: As in the rejection of claim 3, step (e) does not need to be performed if the message is deliverable in step (b). Therefore, Mead clearly performs the method as claimed.).

With regard to claim 5, Mead discloses that step (c) comprises periodically attempting delivery of the message from the relay server to the messaging server (Mead: As in the rejection of claim 1, step (b) does not need to be performed if the message is deliverable in step (b). Therefore, Mead clearly performs the method as claimed.).

With regard to claim 7, Mead discloses

(d) sending the message to the messaging server in response to step (c) (Mead: As in the rejection of claim 1, step (c) does not need to be performed if the message is deliverable in step (b). Therefore, Mead clearly performs the method as claimed.).

With regard to claim 8, Mead discloses

(f) sending the message to the other messaging server in response to step (e) (Mead: As in the rejection of claim 3, step (e) does not need to be performed if the message is deliverable in step (b). Therefore, Mead clearly performs the method as claimed.).

With regard to claim 11, Mead discloses that the relay server is operable to route the message to the other messaging server (Mead: Figure 1. By utilizing network 104, which according to paragraph [0015] may include the Internet, the relay server is able (operable) to route the message to any other messaging server connected to network 104 (which may be the Internet).).

With regard to claim 12, Mead discloses a storage device operably connected to the relay server and the other messaging server, the message being stored in the storage device (Mead: Figure 1 and paragraph [0015]. As Mead is dealing with e-mails, there is at least some storage in each of the servers to store the e-mail, at least temporarily.); and

wherein the relay server is operable to change server information of the stored message to route the message to the other messaging server (Mead: Figure 1. Server information is changed whenever a message is sent to a different destination server, as the message must be addressed to the destination. There is no requirement of what changing the server information entails.).

With regard to claim 13, Mead discloses that the relay server is operable to periodically attempt delivery of the message from the relay server to the messaging server (Mead: Paragraph [0031]).

With regard to claim 15, Mead discloses that the relay server is operable to send the message to the messaging server in response to the re-routing (Mead: Figure 1. The ground (relay) server is able to send the message to the vehicle (messaging) server at any time, whether in response to the re-routing or not.).

With regard to claim 16, Mead discloses that the relay server is operable to send the message to the other messaging server in response to routing the message to the other messaging server (Mead: Figure 1. The ground server is able to send the message to any server connected to network 104 at any time.).

With regard to claim 17, Mead discloses that the messaging server and relay server are within a first data center.

With regard to claim 18, Mead discloses that the messaging server and other messaging server are in first and second data centers, the first data center remote from the second data center.

With regard to claim 19, Mead discloses that the relay server is operable to invoke a process to create another messaging server with a same name and IP address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of "DNS (domain name system)" posted on the Internet February 29, 2000 on whatis.com, and downloaded from <http://web.archive.org/web/20000307002913/whatis.com/dns.htm>, hereafter referred to as "whatis.com."

With respect to claim 9, the instant claim is substantially similar to claim 1 (see above for claim 1 rejected under Nelson) and is rejected for substantially same reasons, except Nelson does not disclose a DNS server operable to route a message to the messaging server.

whatis.com discloses that DNS is the way that the Internet domain names are located and translated into IP addresses. Therefore, any implementation of the invention in the modern Internet would likely have a DNS server operable to route a message to the messaging server.

It would have been obvious to have a DNS server operable to route a message to the messaging server.

The suggestion/motivation for doing so would have been that Nelson discloses that the system and method disclosed by Nelson may be implemented using data

communications networks such as the Internet (Nelson: Column 10, lines 16-23). In order to utilize domain names on the Internet, a DNS server is needed. Domain names allow a user to use an easy-to-remember handle rather than the series of numbers that represents an IP address (whatis.com: Paragraph 1).

With regard to claims 11-13 and 15-16, the features claimed are substantially similar to that claimed in claims 3-5 and 7-8, and are rejected for substantially similar reasons.

With regard to claim 17, Nelson as modified by whatis.com teaches the invention as substantially claimed except that the messaging server and relay server are within a first data center.

However, having the messaging server and relay server within a first data center is not a distinction that changes the functionality of the claimed system.

It would have been obvious to have the messaging server and relay server within a first data center.

The suggestion/motivation for doing so would have been that depending on a company's needs, having the servers in the same data center may be a desirable feature for more efficient communications (as the communication path between the messaging server and the relay server would be relatively short), easier maintenance (as the messaging server and relay server would be in the same location).

With regard to claim 18, Nelson as modified by whatis.com teaches the invention as substantially claimed except that the messaging server and other messaging server are in first and second data centers, the first data center remote from the second data center.

However, having the messaging server and relay server within a first data center is not a distinction that changes the functionality of the claimed system.

It would have been obvious to have the messaging server and relay server within a first data center.

The suggestion/motivation for doing so would have been that depending on a company's needs, having the servers in the different data centers remote from each other may be desirable if the company is a smaller company that is contracting the services provided by the first messaging server and the other messaging server (which is part of the FAX messaging platform of Nelson), therefore allowing the other messaging server to perform functions for multiple data centers.

With regard to claim 19, Nelson as modified by whatis.com teaches the invention as substantially claimed except that the relay server is operable to invoke a process to create another messaging server with a same name and IP address.

A person of ordinary skill in the art would have known how to have the relay server operable to invoke a process to create another messaging server with a same name and IP address in the system of Nelson.

It would have been obvious to have the relay server operable to invoke a process to create another messaging server with a same name and IP address in the system of Nelson.

The suggestion/motivation for doing so would have been that the portion of the FAX messaging platform of Nelson that is utilized to forward the message when the recipient is able to receive the message could be divided to logical portions, each with a section of memory for storing the message and the proper forwarding information. Each of the logical messaging servers would have the same name and IP address as the FAX messaging platform, which is, at least in part, interpreted as being a messaging server.

Claim Rejections - 35 USC § 103

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozzie.

With regard to claim 17, Ozzie discloses the invention as substantially claimed (see above for claim 9 rejected under Ozzie) except that the messaging server and relay server are within a first data center.

However, having the messaging server and relay server within a first data center is not a distinction that changes the functionality of the claimed system.

It would have been obvious to have the messaging server and relay server within a first data center.

The suggestion/motivation for doing so would have been that depending on a company's needs, having the servers in the same data center may be a desirable feature for more efficient communications (as the communication path between the messaging server and the relay server would be relatively short), easier maintenance (as the messaging server and relay server would be in the same location).

With regard to claim 18, Ozzie discloses the invention as substantially claimed (see above for claim 9 rejected under Ozzie) except that the messaging server and other messaging server are in first and second data centers, the first data center remote from the second data center.

However, having the messaging server and relay server within a first data center is not a distinction that changes the functionality of the claimed system.

It would have been obvious to have the messaging server and relay server within a first data center.

The suggestion/motivation for doing so would have been that depending on a company's needs, having the servers in the different data centers remote from each other may be desirable if the company is a smaller company that is contracting the services provided by the first messaging server and the other messaging server (which is part of the FAX messaging platform of Nelson), therefore allowing the other messaging server to perform functions for multiple data centers.

With regard to claim 19, Ozzie discloses the invention as substantially claimed (see above for claim 9 rejected under Ozzie) except that the relay server is operable to invoke a process to create another messaging server with a same name and IP address.

A person of ordinary skill in the art would have known how to have the relay server operable to invoke a process to create another messaging server with a same name and IP address in the system of Nelson.

It would have been obvious to have the relay server operable to invoke a process to create another messaging server with a same name and IP address in the system of Nelson.

The suggestion/motivation for doing so would have been that the portion of the relay server that is utilized to forward the message when the recipient is able to receive the message could be divided to logical portions, each with a section of memory for storing the message and the proper forwarding information. Each of the logical messaging servers would have the same name and IP address as the relay server, which is, at least in part, interpreted as being a messaging server.

(10) Response to Argument

Issue 1: On page 5, Appellant argues that the rejection under 35 USC 102(e) under Nelson is "astounding because the Board of Patent Appeals and Interferences, in it's July 31, 2007 decision in Appeal No. 2007-1044, enclosed herewith in the Related

Proceedings Appendix, has already reversed a rejection of these claims under 35 U.S.C. § 103(a) over *Nelson* in combination with other references.”

However, it is noted that Nelson was only addressed on pages 7-8 of the decision. The decision only reviewed Nelson as a proposed reference to modify McDowell, but did not address Nelson alone. The decision found that Nelson was improper to modify McDowell, stating “the only predictable result that may be achieved by storing the e-mail in McDowell and resending it to the same ISP is that the message will still be undeliverable since the recipient no longer subscribes to the old ISP” and that the “differences between the cause of messages being undeliverable and the mechanism for re-routing the messages of McDowell and Nelson would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the instant claims require.”

Accordingly, the rejection of the instant claims under 35 USC 102(e) under Nelson does not contradict the decision of July 31, 2007, as Nelson was never evaluated alone with respect to the claims, but was instead evaluated as being a proposed modification for the McDowell reference.

Issue 2: On pages 6-7, Appellant argues that Nelson does not enable a person of ordinary skill in the art to allow fax machines to send messages over a computer network.

However, it is first noted that Nelson specifically discloses that facsimile and voice messages may be transmitted using a data communications network, such as the

Internet (Nelson: Column 10, lines 20-23). Further, it is noted that Applicant provides no details on how a person of ordinary skill in the art would not have been able to perform this functionality. Facsimile messages are simply images of a paper, which may be a document or a picture of some sort. In a traditional facsimile communication, the fax machine scans the image, converting it into a signal that can be transmitted over a phone line. The recipient then converts that signal into a print job that is then used to reproduce the document.

Meanwhile, network communications is performed by converting a file into a signal, then transmitting the signal to a recipient machine, which then converts that signal back into a file. Further, scanners were well known in the art at the time of the invention, meaning that it would have been well known to scan a document into a computer system to create a file. Further, printers were well known in the art to convert a file into a printed format.

Thus, a facsimile transmission over the Internet is simply a combination of known technologies (a scanner, a printer, and a network communication). Further, the function of sending a fax message over the Internet (or another communication network) was already known. For instance, US Patent 5,949,859 to O'Toole is titled "AIN Based Internet Fax Routing," and is directed towards transmitting facsimile messages over the Internet. Thus, it is clear that routing facsimile messages over the Internet was known at least as early as the filing date of 5,949,859 of 1997. Therefore, Nelson would clearly have enabled a person of ordinary skill in the art to transmit a facsimile message over the Internet.

Issue 3: On pages 8-9, Appellant argues that Nelson does not disclose "invoking another messaging server.

First, it is noted that Appellant never defines what is meant by "invoking." Thus, "invoking" may be interpreted as being similar to "using." The fax messaging platform, thus, is invoked in order to allow delivery of the message.

Appellant argues, however, "Clearly, Fax Messaging Platform 134 cannot serve as both the 'relay server' and the 'another messaging server' of claim 1" stating that "Nelson does not disclose Fax Messaging Platform 134 acting as the 'relay server' and delivering a message to itself as the 'another messaging server...'" However, it is noted that claim 1 only require that another messaging server is invoked, but does not require that the relay route the message to the invoked messaging server, meaning that Appellant's argument is erroneous with respect to claim 1. Thus, Nelson anticipates claim 1.

Further, claim 3, which does require that the message is routed to the other messaging server does not state from where it is routed. It is noted that step (c) of claim 1 does state "re-routing the message from the relay server to the messaging server...", making the lack of a source in claim 3 peculiar.

Thus, the routing of claim 3 does not require the message is routed from the relay server to the other messaging server, meaning that the Fax Messaging Platform of Nelson can still be equivalent to both the relay server and another messaging server in claim 3.

Further, as discussed below in Issue 7, this limitation is not even required to disclose the claim as a whole, as this limitation only occurs "when the messaging server in step (c) does not become operational." Thus, as Mead discloses at least what occurs when the messaging server becomes operational, Mead clearly discloses the claim as a whole.

Issue 4: Appellant argues that the DNS reference was not available as of February 29, 2000, and was instead posted on February 16, 2004. However, as stated in the Office Action mailed 12/31/2007 on page 26, the February 16, 2004 article includes hyperlinks corresponding to certain words, such as "access provider." The archived copy from the Wayback Machine, with the date of February 29, 2000 does not include these hyperlinks (in the references, the hyperlinks are denoted by underlined words, where the February 16, 2004 article has underlined words where the February 29, 2000 article has no underlining.). Appellant has not provided any evidence that the Wayback Machine (www.archive.org) has falsified dates in any way. Further, Appellant has provided no explanation for the hyperlinks that were present in the later reference, but not the earlier reference. The difference in hyperlinks is a clear reason for a later publication date of the current article. Thus, it is unclear how the evidence would not be sufficient to establish the publication date of the DNS reference lacking any evidence of falsification of dates by the Wayback Machine at www.archive.org.

Further, it is noted that the disclosure of the DNS reference is simply a definition for DNS, a definition that has not changed from before the date of filing of the instant

application and the February 16, 2004 date of the later DNS reference. Applicant does not argue that the information was not in the hands of a person of ordinary skill in the art, or that a person of ordinary skill in the art would not know how to implement a DNS server.

Issue 5: Appellant argues on page 11 that Nelson does not disclose "invoking another messaging server," and thus does not render obvious the subject matter of claim 9. However, this is addressed in Issue 3 with respect to claim 1.

Issue 6: Appellant argues on pages 12 and 13 that Ozzie does not disclose "invoking another messaging server." However, as stated above in Issue 3, there is no explicit requirement as to what entails "invoking." In Ozzie, the message is sent to another server (relay), which stores the message until the peer unit returns online (Ozzie: Column 16, lines 43-54). Thus, the relay, which is implemented as a high-speed file server is another messaging server, which is invoked.

Further, as discussed below in Issue 7, this limitation is not even required to disclose the claim as a whole, as this limitation only occurs "when the messaging server in step (c) does not become operational." Thus, as Ozzie discloses at least what occurs when the messaging server becomes operational, Ozzie clearly discloses the claim as a whole.

Issue 7: On pages 14-16, Appellant argues the rejection of the claim under Mead. First, the rational appearing below explains how Mead anticipates claim 1 as currently presented (the rational was originally presented in the Final Rejection mailed 12/31/2007).

Claim 1, which is a method claim, includes four steps:

- (a) routing a message to a messaging server;
- (b) providing the message to a relay server when the messaging server is inoperable such that the message undeliverable to the messaging server;
- (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and
- (d) invoking another messaging server if the messaging server in step (c) does not become operational.

It is noted that for a method claim, each and every step must be performed only in as much detail as required by the claim language.

In the instant case, step (a) must occur.

However, step (b) only occurs “**when** the messaging server is inoperable such that the message undeliverable to the messaging server.”

Step (c) occurs only **if** step (b) occurs (as the message is only delivered to the relay server when the messaging server is inoperable, and step (c) re-routes the message from the relay server. Step (c) clearly cannot occur if the relay server does not have the message).

Step (d) only occurs if step (c) occurs, as step (d) explicitly recites its dependency on step (c).

Thus, if a reference discloses a method where a message is routed to a messaging server that is operational, the instant claim is anticipated, for these reasons:

- (a) the message is routed to the messaging server;
- (b) the messaging server is operable, so the message does not need to be provided to a relay server;
- (c) the message was never routed to the relay server, and the messaging server was always operable, so the message does not need to be "re-routed";
- (d) as the messaging server is operational, and was not operational for the entire method, step (d) does not need to occur.

Other claims include steps that further depend on the other steps. For example, claim 3 presents "(e) routing the message to the other messaging server of step (d)," which clearly occurs only if step (d) occurred. Therefore, as each claim appears to be dependent on one of steps (b) through (d) occurring to actually occur (or the claim directly modifies a step, such as claim 5, where step (c) periodically attempts delivery of the message).

Appellant argues that Mead does not disclose steps (b), (c), or (d). However, Appellant fails to address the fact that each of steps (b), (c), and (d) each include

conditional statements, where the step only occurs when certain conditions are met, and there is no requirement in the claim that the specific conditions occur. For example, as stated above, if messaging server is operable, then steps (b), (c), and (d) do not occur because each only occurs when the messaging server is inoperable. Further, there is no requirement in the claim that the messaging server is inoperable.

As a note, step (d) is only performed in situations where the messaging server was inoperable, and never becomes operable. Thus, if a reference discloses that a messaging server becomes inoperable, then subsequently becomes operable, step (d) does not need to be performed.

As such, there are at least three embodiments that of claim 1 that occur based on conditions. First, the messaging server is operable. Second, the messaging server is inoperable, but then becomes operable. Third, the messaging server is inoperable and never becomes operable.

Further, on page 16, Appellant states "It is elementary that a reference cannot anticipate a claim without disclosing all of the claims limitations." This statement is incorrect. For example, a Markush claim (e.g. wherein A is one of a group consisting of B, C, or D) does not require each item from the list to be disclosed in a reference. A reference may anticipate the claim even when it discloses only one item from the list. To anticipate a claim, a reference must disclose the claim as a whole. This is not to say that limitations may be ignored, but rather the claim must be evaluated as a whole in order to determine the full scope of the claim. Then, if the reference discloses any single embodiment within the scope of the claim, the reference can anticipate the claim.

As stated above, there are at least three embodiments, and Mead discloses at least one of the embodiments (where the messaging server is operable). Thus, Mead anticipates the method claim as a whole.

Issue 8: Appellant argues on pages 16-17 that Mead does not disclose the subject matter of claim 9. However, contrary to Appellant's arguments, there is no requirement that the DNS server is programmed or otherwise directed to perform any functionality. The DNS server is merely "operable" to route messages in a certain fashion. However, as stated in the rejection of claim 9, a DNS server is operable to route messages to any destination that it is directed to route the messages. In this case, there is no claim language that requires the DNS server to actually route the messages, or automatically reroute the message based on whether the messaging server is operable or not. Below is the interpretation that appeared in the rejection mailed 12/31/2007.

Meanwhile, claim 9 includes terms such as "operable." For example, "a DNS server operable to route a message to the messaging server...the DNS server **operable** to provide the message to the relay server when the messaging server is inoperable..." However, the term "operable" only requires that the DNS server is capable of this functionality. As a DNS server is capable of forwarding messages to any device that is connected to the network, a DNS server is operable to perform the functionality in this specific instance. The claim does not require that the DNS server do the forwarding automatically based on the messaging server being inoperable, only that the DNS server is operable (e.g. capable) to provide a message to a specific entity.

The numerous terms of "operable" that appear in the claims are interpreted in a similar fashion. If Applicant intends for actions to be taken based on certain conditions (e.g. the messaging server being inoperable), Applicant should amend the instant claims to reflect as much.

On page 17, Appellant states that Mead "does not disclose a DNS server that is operable (i.e. programmed or otherwise directed) to provide a message to a relay server when the messaging server is inoperable." However, the specification fails to define operable as "programmed or otherwise directed," nor does the claim equate operable with "programmed or otherwise directed." The term "operable" actually may be defined as "capable of being put into use, operation, or practice," which clearly does not require any specific programming or direction to perform the functionality, only the capability to be put into use for the functionality.

Thus, due to the use of the term "operable" without any requirement that the functionality is actually performed, Mead anticipates the subject matter of claim 9, as a DNS server is fully capable of forwarding a message to any destination when instructed to do so.

Issue 9: On pages 17-18, Appellant argues the rejection under 35 USC 112 of claim 18. A statement that this rejection was withdrawn was inadvertently omitted from the Advisory Action mailed on 4/25/2008.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/S. C./

Examiner, Art Unit 2144

/William C. Vaughn, Jr./

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/William C. Vaughn, Jr./

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